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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,768	12/05/2003	Peter M. Bonutti	2500DV2CN2DV3CN5	3380
7590 03/15/2005				
Kimberly V. Perry, Esq.		EXAMINER		
U.S. Surgical		THALER, MICHAEL H		
A Division of Tyco Healthcare Group, LP				
150 Glover Avenue		ART UNIT		
Norwalk, CT 06856		3731		
DATE MAILED: 03/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/729,768	BONUTTI, PETER M.	
	Examiner	Art Unit	
	Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-25 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/5/04, 2/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Feb. 18, 2005. Contrary to applicant's remarks, claims 23-25 do not read on the elected species. Claim 23 reads on the species shown in figures 11 and 11A rather than the elected species described on page 15, lines 3-9. Note that the description on page 15, lines 3-9 refers to wedge-shaped filaments rather than a wedge-shaped bladder. Claim 25 reads on the species described on page 19, lines 8-13 rather than the elected species. Claim 24 reads on the species shown in figures 11 and 11A and/or the species described on page 19, lines 8-13 rather than the elected species.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 15, line 4, the meaning of the term "non-uniform shape" is unclear. The specification

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defines this term on page 15, lines 3-7 as a shape that will expand in a non-uniform manner but includes a round shape (shown in figure 5A) as an example of a non-uniform shape. Since a round shape (or a circular shape as defined in claim 22), by definition, is uniform since it is symmetrical about its center point, the meaning of the term "non-uniform shape" is unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 15-18, 20 and 22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jakubczak (4,651,717). Jakubczak discloses shaft 214 and inflatable bladder 201 which has a non-uniform, (i.e. conical) shape when inflated. The Jakubczak device is a retractor since it moves tissue. Alternatively, it would have been obvious that the Jakubczak device is a retractor since it moves tissue. As to claim 16, the inflatable bladder 201 in the figure 7 embodiment does not stretch (at least in the lateral direction) since it is located on mesh 700 which apparently does not stretch.

Claims 15 and 17-20 and 22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Solano et al. (4,921,478). Solano et al., in figure 5C, disclose shaft 22 and inflatable bladder 16 which has the non-uniform shape of a wedge when inflated (since it tapers in the distal direction). The Solano et al. device is a retractor since it moves tissue. Alternatively, it would have been obvious that the Solano et al. device is a retractor since it moves tissue. As to claims 19 and 20, shaft 22 is rigid in portion 38 and flexible in portion 36.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Solano et al. (4,921,478). Solano et al. fail

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to disclose a cannula. However, it is old and well known in this art to use a cannula when inserting a catheter in the body in order to obtain the advantage of smoothly and accurately facilitating its insertion. It would have been obvious to use a cannula with the Solano et al. catheter so that it too would have this advantage.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Haber et al. (4,802,479), already of record, disclose a rigid shaft.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
3/10/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731